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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,213	01/29/2004	Mitsuhiro Yuasa	01165.0911	3344

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EXAMINER

STARK, JARRETT J

ART UNIT	PAPER NUMBER
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2823

MAIL DATE	DELIVERY MODE
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05/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/766,213	Applicant(s) YUASA, MITSUHIRO	
	Examiner Jarrett J. Stark	Art Unit 2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 3-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/6/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 3-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/2/2007.

Claim Objections

Claims 7-18 are objected to because of the following informalities:

Appropriate correction is required.

Claims 7-18 recites the limitation "sealing member " in the claims. There is insufficient antecedent basis for this limitation in the claim.

The claims also are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 9 recites the limitation "prevents interference with members formed in first substrate." There is no previous claim to forming "members" in the first substrate. Therefore there is insufficient antecedent basis for this limitation in the claim.

Claim 11 is objected to as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The usage of the terminology "is realized with" does not particularly point out and distinctly claim the subject matter which applicant regards as the invention. The meaning of this phrase is not clearly realized by the Office.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 7-9, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al. (US 5,403,916):

Regarding claim 1, Watanabe disclose a bonding method comprising the steps of:

bringing a first substrate and a second substrate into contact with each other (Watanabe, Col. 16 Ins 22-30); and

radiating light having a wavelength that is absorbed into said first substrate but not into said second substrate, to the interface between said first substrate and said second substrate for bonding said first substrate and said second substrate (Watanabe, Col. 16 Ins 31-38).

Regarding claim 2, Watanabe disclose a bonding method according to claim 1 wherein, at said bonding step, said first substrate and said second substrate are pressed (Watanabe, Col. 2 Ins 62-65).

Regarding claim 7, Watanabe disclose a sealing member that is employed as said second substrate according to the bonding method set forth in claim 1 and that is made of glass.

Regarding claims 8, 12 and 15, Watanabe disclose a sealing member according to claim 7, wherein said sealing member has the same shape as said first substrate and has alignment marks inscribed therein. The shape does not manipulatively distinguish the claim. Structural Elements recited in the claim must manipulatively distinguish the claim from the prior art to have patentable weight.

"To be entitled to patentable weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure."

Ex parte Pfeiffer, 135 USPQ 31,k 33 (Bd. Pat. App & Inter. 1961). Put another way, "patentability of a method claim must rest on the method steps recited, not on the structure used, unless that structure affects the method steps." Leeson Corp. v. U.S., 185 USPQ 156, 165 (Ct. Cl. Trial iv. 1975) aff'd 192 USPQ 672 (Ct. Cl 1976).

Regarding claim 9, Watanabe disclose a sealing member according to claim 7, wherein said sealing member has recesses that prevent interference with members formed in said first substrate.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2823

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-11, 13-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 5,403,916), in view of Tseng (US 2003/0071269 A1).

Regarding claims 10, 13 and 16, Watanabe in view of Tseng discloses a sealing member according to claim 7, however does not explicitly disclose wherein said sealing member has a light shielding material applied to predetermined part thereof. At the time of the invention it was obvious to one of ordinary skill in the art to perform selective bonding by applying a light shielding material. Tseng discloses the method of applying a mask in paragraphs [0052] → [0053] to bond glass to a silicon substrate.

It would have been within the scope of one of ordinary skill in the art at the time of the invention to combine the teachings of Watanabe and Tseng to enable the bonding step of Watanabe to be performed according to the teachings of Tseng because one of ordinary skill in the art at the time of the invention would have been motivated to look to alternative suitable methods of performing the disclosed bonding step of Watanabe and art recognized suitability for an intended purpose has been recognized to be motivation to combine. MPEP § 2144.07.

Art Unit: 2823

Regarding claim 11, Watanabe in view of Tseng discloses a sealing member that is employed as said second substrate according to the bonding method set forth in claim 1 and that is realized with a plastic film having thermoplasticity (Tseng, [0050]).

Regarding claims 14, 17 and 18, Watanabe in view of Tseng discloses a sealing member that is employed as said second substrate according to the bonding method set forth in claim 1 and that has an adhesive which adheres to said first substrate when illuminated with light (Tseng, [0050]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jarrett J. Stark whose telephone number is (571) 272-6005. The examiner can normally be reached on Monday - Thursday 7:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Smith can be reached on (571) 272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jarrett J Stark
Examiner
Art Unit 2823

JJS
May 14, 2007


MICHELLE ESTRADA
PRIMARY EXAMINER